

IN THE HIGH COURT OF GUJARAT AT AHMEDABAD

APPEAL UNDER SECTION 109 No 11 of 1993

AND

APPEAL UNDER SECTION 109 No 12 01 993

For Approval and Signature:

Hon'ble MR.JUSTICE R.BALIA.

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1. Whether Reporters of Local Papers may be allowed to see the judgements? Yes

2. To be referred to the Reporter or not?

3. Whether Their Lordships wish to see the fair copy of the judgement?

4. Whether this case involves a substantial question of law as to the interpretation of the Constitution of India, 1950 of any Order made thereunder?

5. Whether it is to be circulated to the Civil Judge?

2 to 5 No

MISHRI LAL GORDHAN LAL

Versus

LALIT KUMAR ARYA

Appearance:

MR MC BHATT for Petitioner

MR AKIL KURESHI for Respondent No. 1

CORAM : MR.JUSTICE R.BALIA.

Date of decision: 20/06/98

ORAL COMMON JUDGEMENT

1. These two Appeals arise out of common order passed by the learned Assistant Registrar under Trade & Merchandise Marks Act, 1958 (Hereinafter called the Act) rejecting the appellant's applications for registering numerical '64' and a label numbered as '64' both in words and figures as their registered Trade marks and in

connection with the commodity traded by the appellant, namely, "SNUFF". The applications were rejected by order dated 10th March, 1993. The commodity with respect of which two applications were made by the appellant is 'Snuff" manufactured by the appellant. One application is for registering numerical Mark '64' as the trade mark on the basis that the appellants were using it for last more than 20 years i.e. to say since 1964 and the application was moved on 25th April, 1984 which is Application No. 421059. Similarly, another application No.458581 was moved for registering a Label Mark consisting of the numerical '64', both in figures as well as in words under class 34. The user of the label consisting the mark was claimed to be since January, 1979. The applications were advertised under Section 21 of the Act, in pursuance of which, notice of opposition was lodged by the respondent - opponent alleging that the trade mark proposed for registration by the applicant consisting mainly numerical '64' is the same and similar to the trade mark owned by the opponent. The opponent has secured registration of numerical '64' as their trade mark in various forms which shall be referred to hereinafter. From the notice of opposition, it appears that respondent opponent had four different trade marks registered in its favour carrying '64' as numerical number associated with its products, viz. chewing tobacco and quiwam. All the four marks are registered under class 34 and found place in respective TMJ No.620 dt. 10.4.75, 671 dated 5.1.77, 695 dated 16.5.77 and 812 dated 1.4.83. Learned Assistant Registrar found that the registration to the opponent has been granted on the basis of user of the mark by them since 1966. It further concluded that the applicant has claimed user of the mark Numerical '64' for marketing their commodities since 1964, that is to say, prior to the use of claim by opponent. They have not produced any evidence in support that they were using Numerical '64' since 1964, but they have been able to establish that they are using the marks since 1973. Thus, the right of applicant on the basis of prior use of the mark then opponent did not find favour with the Assistant Registrar. Prayer for considering the registration under Section 12(3) of the Act was also refused on the ground that the concurrent user of the mark '64' since 1973 by the applicant cannot be considered bona fide and honest so as to entitle consideration under Section 12(3) for registering it in favour of the applicant. On those findings, both the applications were rejected.

2. Learned counsel for the applicant has challenged both the findings as well as also the conclusion that the

opponents have failed to establish by cogent evidence that mark used as trade mark has a reputation and good will in connection with goods manufactured by them.

3. So far as the contention of the learned counsel for the appellant challenging the finding against the appellant in respect of user of the mark since 1964 is concerned, the same cannot be accepted. Learned Assistant Registrar has categorically stated in its order that no documentary evidence has been filed in support of the claim that the numerical Marks '64' under application No. 421059 is used by applicant since 1964. But, they have furnished evidence in this regard only from the year 1973 onwards. This conclusion is drawn from material on record. Learned counsel for the appellant is not able to refer to any other material on the basis of which it can be said that the Assistant Registrar has not considered the material before it or that there was any evidence before the registering authority about user of the trade mark by the applicant since 1964.

4. The second contention of the learned counsel for the appellant that the Assistant Registrar in considering the question of registration of trade mark under Section 12(3) has ignored the fact that the commodity in connection with which the registration was sought by the appellant was entirely different from the one in respect of which opponent claimed their right to use the mark which has resulted in grossly erroneous conclusion by the Assistant Registrar. This contention, in my opinion, is well founded and deserves acceptance.

5. Undisputedly, the commodity in association with registration was sought by the appellant is "Snuff" and the opponent has claimed proprietorship of registered trade mark consisting of Numerical '64' in their favour in association with the commodity chewing tobacco and quiwam. Undoubtedly, tobacco forms the raw material for both the commodities, but, in the commercial parlance and for the ultimate consumers or the buyers of the commodities, these two are distinct and different commodities. While 'Snuff' is a commodity used for inhaling and not used for chewing or smoking. Like commodity the chewing leaves of tobacco or quiwam is not used for inhaling. The users of 'snuff' or 'chewing tobacco' in any part of the country are not likely to be confused about their required merchandise by similarity of mark or label. While buying the goods required by them, a person who is requiring chewing leaf is not likely to buy snuff on the basis of label placed on it. It appears that learned Assistant Registrar has swayed by

the fact that both are tobacco products ignoring the fact that the registration was neither sought by the applicant nor obtained by the opponent in connection with tobacco products generally but was sought in connection with special tobacco product distinctly known in the market as "snuff" and "chewing tobacco". If it is to be kept in mind, starting user of mark '64' by the appellant in 1975 in connection with 'snuff' prior to the registration of such mark by the opponent could not be per se dishonest or mala fide use of the opponent's trade mark to deceive or confuse the buyers of the opponent's commodity.

6. I am therefore of the opinion that by not taking into consideration the distinctive nature of commodity in respect of which the applicants have sought the registration of numerical '64' as trade mark, user of which he has established since 1973, the Assistant Registrar has not considered the application under Sec. 12 read with 12 (3) in correct perspective.

7. Accordingly, these Appeals are allowed. The orders under appeal are set aside and the Assistant Registrar is directed to proceed further in connection with the two applications in accordance with law. There shall be no order as to costs.

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